



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/079,758 05/15/98 MORRISON

D MSC-22939-1-

024957 HM12/0313
NASA JOHNSON SPACE CENTER
MAIL CODE HA
2101 NASA RD 1
HOUSTON TX 77058

EXAMINER

SHARAREH, S
ART UNIT

PAPER NUMBER

1619
DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/079,758

Applicant(s)

Morrison et al

Examiner
Shahnam Sharareh

Group Art Unit
1619



☒ Responsive to communication(s) filed on Dec 12, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 2, 4-45, and 47-71 is/are pending in the application.

Of the above, claim(s) 60-68 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-45, 47-59, and 69-71 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 60-68 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1619

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2000 has been entered.

Status of the Claims

2. The amendment filed on December 20, 2000 has been entered. Claims 1, 4, 41, 44, 47, and 69 are amended, claims 3, 46 are canceled. Claims 1-2, 4-45, 47-71 are pending. Claims 1-2, 4-45, 47-59, 69-71 are under consideration, claims 60-68 stand withdrawn as set forth in Paper No. 5. Examiner request confirmation of the status of the claims and a copy of all pending claims in response to this Office Action.

This application contains claim 60-68 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. The instant Application is a continuation-in-part of US Application No. 08/349,169 filed December 2, 1994, now US Patent 5,827,531.

Art Unit: 1619

Response to the Amendment

4. Applicant's arguments with respect to the rejection under 35 U.S.C. 102(e) as being anticipated by Unger et al US Patent 5,852,752 have been fully considered but are persuasive in view of the amendments made to claims 1, 4, 41, 44, 47, and 69. This rejection is withdrawn.

Applicant's arguments with respect to the rejection of the claims under 35 U.S.C. 102(b) as being anticipated by Grinstaff et al US Patent 5,498,421 have been fully considered and are found persuasive in view of the amendments. This rejection is withdrawn.

Applicant's arguments with respect to the rejection of the claims under 35 U.S.C. 102(b) as being anticipated by McGinity et al US Patent 5,288,502 have been fully considered and are ~~not~~ persuasive in view of the amendments. This rejection is withdrawn

Applicant's arguments with respect to the rejection of the claims under 35 U.S.C. 102(b) as being anticipated by Tsuei et al US Patent 5,589,194 have been fully considered and are found persuasive in view of the amendments to the claims. This rejection is withdrawn

Applicant's arguments with respect to the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Tsuei et al US Patent 5,589,194, and Unger et al US Patent 5,853,752 have been fully considered and are found persuasive in view of the amendments to claims. This rejection is withdrawn.

New Grounds of Rejection

Claims 1-2, 4-45, 46-59, 69-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1619

The amendments to the independent claims 1, 4, 41, 44, 47, and 69 created inconsistencies in the claim language. The transitional phrase “consists of” limits the instant composition to the elements of the broad claim. A claim which depends from a claim which “consists of” the recited elements or steps cannot add an element or step, MPEP 2111.03.

In the instant case, claim 1 recites a microcapsule consisting of ONE or more internal, immiscible liquid phases..... The language of a microcapsule consisting of One immiscible liquid phase renders the claim vague, because clearly two liquids are required to create an immiscible phase. Examiner recommends omission of the term “one”. In addition, the language of claim 1 reciting “further consisting of one or more energy absorbing components...” is confusing. Further, there is a inconsistency in the use of transitional phrases. A dependent claim can not be broader than the its independent base claim. Claim 1 recites the microcapsule to consisting of one or more internals, and further consisting of one or more energy absorbing components selected from the group..... Claim 2 recites that the energy absorbing component is a magnetic particle. None of the energy absorbing groups recited in group 1 appear to be a magnetic particle. Accordingly, claim 2 appears to be improperly dependent on claim 1. Claim 5 recites that the microcapsules comprises at least one internal aqueous phase and at least one internal hydrocarbon phase. The transitional phrase “comprise” in claim 5 encompass broader group of compositions than claim 1.

Claims 7-23, 27 introduce a new component to the independent claim 1. For example claim 7 recites addition of a drug or drug precursor, claim 27 recites addition of a coating (magnetic particles comprise a coating). Examiner recommends incorporation of such claims into

Art Unit: 1619

the broader claims. For example, claim 7 can be incorporated into claim 1, so that claim 1 substantially reads “ further consisting of one or more energy absorbing components selected from the group A, B, C and a drug or drug precursor.....”.

Claim 36-39 introduces a new component to the independent claim 1, and thus appear to be broader than claim 1. This is improper dependency.

Claim 41 recites compositions consisting of one or more magnetic particles selected from the recited group. However, claims 42 adds a new component to claim 41. Examiner recommends incorporation of claim 42 into claim 41 as described above.

Similarly the method claims 44, 47 and their dependent claims 45-48, 51-59, and the composition claims 69-71 are improperly dependent.

The claims are replete with 112 second paragraph issues. Applicant is requested to carefully review all claims for consistency of transitional phrases and limitations.

The term SMO-20 appears to be a tradename. The use of a tradename in the claim language is not permitted. Examiner requests clarification of this term.

Conclusion

5. No claims were allowed. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

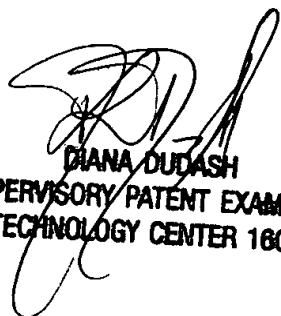
Art Unit: 1619

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh, PharmD whose telephone number is (703) 306-5400. The examiner can normally be reached on Monday to Friday from 9:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Diana Dudash can be reached on 703-308-4628. The fax phone number for this Group is 703-308-4556. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-

1235.

sj/s, 3/07/01


DIANA DUDASH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600